

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
U.S. Application No. 10/017,394
Attorney Docket No. Q67780

REMARKS

Reconsideration and allowance of this application are respectfully requested. Claims 1, 6, 12, 13 and 15 have been amended. Claims 1-18 are pending in the application. The rejections are respectfully submitted to be obviated in view of the remarks presented herein.

Objection to the Specification

The specification has been objected to because it allegedly appears to be a literal translation of a foreign document. Applicants maintain that the as-filed specification is in proper idiomatic English, and are not aware of any instances of improper idiomatic English. Applicants also believe that the as-filed specification is in compliance with 37 C.F.R. § 1.52(a) and (b). Although reference is made to page 5, lines 13-23 of the specification the Applicants cannot find any particular instances of improper idiomatic English.

Particularly, 37 C.F.R. § 1.52(b)(ii) requires the application to be in the English language. Applicants submit that the specification as-filed meets these requirements so as to be written in English clearly disclosing the present invention. Applicants respectfully request the Examiner to adhere to the standards as set forth in 37 C.F.R. § 1.52(a) and (b), and not subject Applicants to an unduly high standard. Therefore, withdrawal of the objection to the specification is respectfully requested.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 1-18 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejection is again respectfully traversed.

Applicants maintain that the claims are in proper idiomatic English, adhering to all requirements of 35 U.S.C. § 112, and are not aware of any instances of grammatical or idiomatic errors. Applicants also believe that the claims are not indefinite, and are clear in pointing out and distinctly claiming exemplary embodiments of the present invention. For example, claim 1 recites a server, comprising a storage section, a corresponding information storage section, an output section, and a storage control section. Claim 7 recites a terminal, comprising a storage section, an acquisition section, a utilization section, an update section, and a return section. Claim 13 recites an information processing system, comprising a server and a terminal, wherein the server comprises a first storage section, a corresponding information storage section, an output section, and a storage control section, and the terminal comprises a second storage section, an acquisition section, a utilization section, an update section, and a return section. Claim 15 recites “a computer-executable server program embodied on a computer-readable medium, the computer-executable server program causing a server computer contained in a server to function as a storage section, a corresponding information storage section, an output section, and a storage control section. Claim 17 recites a computer-executable terminal program embodied on a computer-readable medium, the computer-executable terminal program causing a

terminal computer contained in a terminal to function as a storage section, an acquisition section, a utilization section, an update section, and a return section.

Regarding claims 6 and 12, Applicants have editorially amended claims 6 and 12 to improve clarity. Support for these claim amendments is found in the specification on at least page 50, lines 10-23.

Regarding claims 1, 7, 13, 15 and 17, exemplary embodiments of a plurality of second information pieces stored in one-to-one correspondence with a plurality of first information pieces is clearly described and shown in the specification on at least page 20, line 23 to page 21, line 9, and in FIG. 3. Also, with particular regards to claim 1, the claim recites in an exemplary embodiment, that the server comprises a corresponding information storage section “for storing a plurality of second information pieces in one-to-one correspondence with the plurality of the first information pieces, the second information pieces including content information pieces indicating contents of the first information pieces or attribute information pieces indicating attributes of the first information pieces.” As such, exemplary claim 1 clearly provides a definite interpretation of what is meant by a “one-to-one correspondence.” Therefore, Applicants believe the scope of the claims to be sufficiently clear in regards to this term.

Regarding claims 1, 7, 13, 15 and 17, an exemplary embodiment of a second information piece is shown in FIG. 2(a). As shown in FIG. 2(a), a correspondence information piece T contains information indicating the contents or attribute of the piece of music M to which the correspondence information piece T corresponds. The information pieces (20-28) as shown in FIG. 2(a) are non-limiting exemplary embodiments of the content information pieces or attribute

information pieces as claimed. These claimed elements are also sufficiently defined by the claims, an example of which is recited by claim 1, such that “the second information pieces including content information pieces indicating contents of the first information pieces or attribute information pieces indicating attributes of the first information pieces.”

Regarding claims 1, 13 and 15, the second information piece is output by an output section of a server. Additionally, the outputted second information piece is returned to the server from a terminal. Furthermore, claims 1, 13 and 15 have been amended to more clearly recite that the outputted second information piece, updated at the terminal, is returned from the terminal. Therefore, the outputting and returning of the second information piece is clearly defined by each of amended claims 1, 13 and 15.

Reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, are respectfully requested.

Rejection Under 35 U.S.C. § 102(b) - Herz et al.

Claims 1-18 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Herz et al. (U.S. Patent Number 5,758,257; hereinafter “Herz”). The rejection is again respectfully traversed.

Regarding claim 1, as previously maintained, Herz’s content profiles only describe the contents of video programs, and are used for mathematical comparison to customer profiles to generate the agreement matrix (column 10, lines 6-16). There is no teaching or suggestion in Herz of any plurality of second information pieces which are in one-to-one correspondence with

a plurality of first information pieces. Such a one-to-one correspondence is particularly recited by claim 1, such that the second information pieces include content information pieces indicating contents of the first information pieces or attribute information pieces indicating attributes of the first information pieces. This is not taught or suggested by Herz. The content profiles of Herz, as suggested in column 5, lines 1-5, only “generally indicate the degree of content of the predetermined characteristics in each video program,” and as such do not teach or suggest the claimed second information pieces as specifically recited by claim 1.

Furthermore, there is also no teaching or suggestion in Herz of outputting the first information pieces and corresponding second information pieces to a terminal, and where a storage control section in the server stores updated second information pieces (updated at the terminal) which have been returned from the terminal. The returned second information pieces are stored in place of the second information pieces before outputting in the corresponding information storage section.

Herz’s profiles are not disclosed or suggested to have a one-to-one correspondence with first information pieces, nor are does Herz disclose an output section which outputs the first information pieces to a terminal together with the second information pieces. Further, Herz’s agreement matrix does not function such as to store returned updated second information pieces in place of the second information pieces before outputting in the corresponding information storage section, whereby the returned updated second information pieces are the outputted second information pieces which are updated at the terminal and returned from the terminal to the server. Although Herz generally discloses updating customer profiles on column 6, lines 36-

66, this disclosure does not teach or suggest every element as particularly recited by amended claim 1.

Additionally, the claimed storage by the storage control section of returned second information pieces cannot be inherent (as attributed to buffering) as is alleged by the Examiner. Firstly, although the Examiner states in paragraph 13 on page 3 of the Office Action that “[t]he storage of material before transmission is inherent, and is called buffering,” the claimed invention as recited by claim 1 recites that “the storage control section stores the returned second information pieces in place of the second information pieces before outputting in the corresponding information storage section” (emphasis added). Therefore, the claimed invention (storage control section storing the returned second information pieces) is different from what the Examiner alleges (buffering material prior to transmission). Secondly, inherency requires that such is the *only way*, and in this case necessitates the storage of material before transmission. However, buffering is not necessarily required in cases of transmitting material. Therefore, the Examiner’s allegation of inherency is improper in this context. Furthermore, the claimed storage of returned second information pieces is merely one configuration of a server according to an exemplary embodiment of the present invention.

Therefore, Herz fails to teach or suggest the claimed invention, as recited by claim 1. At least by virtue of the aforementioned differences, the claimed invention distinguishes over Herz. Claims 2-6 are dependent claims including all of the elements of independent claim 1, which as established above, distinguishes over Herz. Therefore, claims 2-6 are allowable over Herz for at least the aforementioned reasons as well as for their additionally recited features.

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
U.S. Application No. 10/017,394
Attorney Docket No. Q67780

Reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b) are respectfully requested.

Regarding claim 7, an exemplary embodiment of the invention relates to a terminal comprising a storage section, an acquisition section, a utilization section, an update section and a return section. Herz fails to teach or suggest the claimed invention for analogous reasons as described above. Claims 8-12 are dependent claims including all of the elements of independent claim 7, which as established above, distinguishes over Herz. Therefore, claims 8-12 are allowable over Herz for at least the aforementioned reasons as well as for their additionally recited features. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b) are respectfully requested.

Claims 13, 15 and 17 disclose a related system, server program, and terminal program respectively, and are allowable over Herz for analogous reasons as described above. Claims 14, 16 and 18 are dependent claims including all of the elements of independent claims 13, 15 and 17 respectively, which as established above, distinguish over Herz. Therefore, claims 14, 16 and 18 are allowable over Herz for at least the aforementioned reasons as well as for their additionally recited features. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b) are respectfully requested.

Double Patenting Rejection of Claim 1

Claim 1 has been rejected under the judicially created doctrine of double patenting over claim 1 of U.S. Patent Number 6,831,798 (Hayashi). The rejection is again respectfully traversed.

In paragraph 16 on page 3 of the Office Action, the Examiner suggests that “the further arguments concerning the storage of information are moot [because the] storage of information before transmission is inherent to a networking device due to the presence of registers and buffers.” However, as discussed above, inherency necessitates the presence of a particular indispensable element or *of something that must be true*, and which is the only configuration possible. On the contrary, the claimed storage of returned second information pieces within the storage control section is not inherent, nor is the storage of a plurality of first information pieces. Storage of returned second information pieces is not necessitated by the recited server, and this is but one possibility which is explicitly claimed. The presence of registers and buffers is also not required for a functioning networking device.

As the Examiner’s reliance on inherency is improper, the Examiner must consider that Hayashi fails to teach or suggest the claimed storage section and storage control section.

In maintaining the rejection, the Examiner again contends that both the instant application and Hayashi disclose the storing of a plurality of information including a first partial information and a second partial information and reproducing the partial informations. However, Hayashi discloses specifically the reproduction of information, in which a plurality of informations is stored, and the plurality of informations includes a first partial information and a second partial information. The first partial information of information of arbitrarily selection information is read out and reproduced, and the second partial information is read out during reproduction of the first partial information, and the read out second partial information is reproduced.

Conversely, Applicants' claim 1 recites a storage section which stores a plurality of first information pieces, and a corresponding information storage section which stores a plurality of second information pieces in one-to-one correspondence with the plurality of first information pieces. The second information pieces include content information pieces indicating contents of the first information pieces or attribute information pieces indicating attributes of the first information pieces. Applicants' claim 1 also recites an output section which outputs the first information pieces to be outputted to a terminal together with the second information pieces corresponding to the first information pieces to be outputted. Furthermore, when the outputted second information piece updated at the terminal is returned from the terminal, a storage control section stores the returned second information pieces in place of the second information pieces before outputting in the corresponding information storage section.

Applicants maintain that the server recited by claim 1 is not disclosed or suggested by Hayashi, and the double patenting rejection is improper. In particular, the storage control section of the server stores returned second information pieces updated at the terminal in place of the second information pieces before outputting in the corresponding information storage section, as recited by claim 1. These claimed elements are not at all taught or suggested by Hayashi, nor does Hayashi's reproduction or partial informations even remotely refer to or suggest second information pieces in one-to-one correspondence with a plurality of first information pieces and including content information pieces or attribute information pieces, but instead only mentions the storing and reproduction of partial information.

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
U.S. Application No. 10/017,394
Attorney Docket No. Q67780

At least by virtue of the aforementioned differences, the claimed invention is not at all disclosed by Hayashi. Reconsideration and withdrawal of the double patenting rejection of claim 1 are respectfully requested.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Lenny R. Jiang
Registration No. 52,432

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: July 17, 2006